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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,802	12/22/2005	Yasushi Washio	SHIGA7.35APC	1118

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EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/561,802	Applicant(s) WASHIO ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>22 December 2006</u> . | 6) <input type="checkbox"/> Other: ____. |

This application is before the examiner for consideration on the merits.

I. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4 of copending Application No. 10/560,155 in view of Pfeifer (3,207,725). The applied claims in 10/560,155 is related ammonium salt(s) of alkyl diphenyl ether sulfonic acid(s) but that of alkali metal salt(s) in the instant claims. However, it is known in the art to use alkali metal(s) and/or ammonium(s) in combination(s) or alternative(s). Evidence, can be seen in at least Pfeifer at col. 2:7-43. There is no

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suggestion of compounds with n being 2 in the general formula in the cited paragraph. There is also no suggestion of an additional compound or dyeable polyolefin composition in Pfeifer. Since the applied claims and Pfeifer are generally related to analogous salts of alkali metal(s) and ammonium(s) of alkyl diphenyl ether sulfonic acid(s), it would have been obvious to one having ordinary skill in the art at the time the invention was made to (1) include an amount of an alkali metal salt of an alkyl diphenyl ether sulfonic acid for reasonable expectation of obtaining an additional benefit of an analogous anionic surfactant in the art and/or (2) use alkali metal salt(s) in place(s) of that (those) of ammonium salt(s) of alkyl diphenyl ether sulfonic acid(s) for a reasonable expectation of obtaining the benefit of analogous anionic surfactant in the art and as disclosed, taught and suggested in Pfeifer.

This is a provisional obviousness-type double patenting rejection.

II. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (5,985,525) considered in view of Pfeifer (3,207,725).

Sato et al disclose, teach and suggest a developer composition and its use. The composition comprising an organic quaternary ammonium base as claimed and an analogous ammonium salt(s) of alkyl diphenyl ether sulfonic acid(s) instead of alkali metal salt(s) thereof in the claims. Please see the whole disclosure of each of the applied references, especially in Sato et al at col.2:41 to 3:55 and 5:12-16.

However, it is known in the art to use alkali metal(s) and/or ammonium(s) in combination(s) or alternative(s) as salt(s) of alkyl diphenyl ether sulfonic acid(s). Evidence, can be seen in at least Pfeifer at col. 2:7-43. There is no suggestion of compounds with n being 2 in the general formula in the cited paragraph. There is also no suggestion of an additional compound or dyeable polyolefin composition in Pfeifer. Since Sato et al and Pfeifer are generally related to analogous salts of alkali metal(s) and ammonium(s) of alkyl diphenyl ether sulfonic acid(s), it would have been obvious to one having ordinary skill in the art at the time the invention was made to (1) include an amount of an alkali metal salt of an alkyl diphenyl ether sulfonic acid for reasonable expectation of obtaining an additional benefit of an analogous anionic surfactant in the art and/or (2) use alkali metal salt(s) in place(s) of that (those) of ammonium salt(s) in alkyl diphenyl ether sulfonic acid(s) for a

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reasonable expectation of obtaining the benefit of analogous anionic surfactant in the art and as disclosed, taught and suggested in Pfeifer.

III. Tanaka et al (5,543,268) and Tanaka et al (6,329,126) have about the same teachings and suggestions as those in the above applied Sato et al. They are cumulative.

Toyama et al (EP 0 272 686 and EP 0 323 836) are related to a sodium alkyl diphenyl ether disulfonate but fail to specify that the disulfonate groups are on the phenyl group other than the alkyl phenyl group as disclosed in the instant claims.

Table 1 with respect to the chemical structures in Japanese priority document has been considered. Accordingly, Takamiya (7,063,937) are cited to show the state of the art.

IV. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
15 September 2006

HOA VAN LE
PRIMARY EXAMINER
